

the instant Restriction Requirement, which alleges that claims 1-32 are pending. The Examiner has requested that the Applicants elect one group under 35 U.S.C. 121 as follows:

- I. Claims 1, 2, and 5-18, drawn to vaccine compositions comprising an antigen and an exogenous hydrophobic peptide, classified in class 424, subclass 193.1.
- II. Claims 1, 3, 4, and 6-18, drawn to vaccine compositions comprising an antigen and an exogenous hydrophobic C8-C18 fatty acyl group, classified in class 424, subclass 193.1.
- III. Claims 19, and 21-32, drawn to methods of inducing a neutralizing antibody response comprising administering to a subject a vaccine compositions comprising an antigen and an exogenous hydrophobic peptide, classified in class 424, subclass 193.1.
- IV. Claims 19-32, drawn to methods of inducing a neutralizing antibody response comprising administering to a subject a vaccine compositions comprising an antigen and an exogenous hydrophobic C8-C18 fatty acyl group, classified in class 424, subclass 193.1.

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks.

The Restriction Requirement with respect to groups III and IV is moot based on the aforementioned Preliminary Amendment which canceled claims 19-32, to which Groups III and IV are directed. Therefore only Groups I and II remain.

Applicants respectfully request that Groups I and II be recombined. These Groups are directed to the same class and related subclass and therefore, it would not be a search burden upon the Examiner. See MPEP §803.

Furthermore, Applicants would like to pursue in this application the vaccine composition of Claim 1. It has long been held that an Examiner may not reject a particular claim on the basis that it represents "independent and distinct" inventions. *See, In Re Weber, Soder and Boksay*, 198 USPQ 328, 331 (CCPA 1978) (emphasis added). *See also, In Re Haas*, 179 USPQ 623, 624, 625 (In Re Haas I) and *In Re Haas*, 198 USPQ 334-337 (In Re Haas II). The courts have definitively ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. §121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In Re Weber, Soder and*

Boksay, In Re Haas I and In Re Haas II. In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim -- no matter how broad, which means no matter how many independently patentable inventions may fall within it. *See, In Re Weber, Soder and Boksay* at 334.

Alleging that a particular claim represents multiple "patentability distinct" inventions is a *de facto* rejection of the patentability of the claim, because the claim cannot issue as drafted. As the CCPA has noted:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

See In Re Weber, Soder and Boksay, Supra.

Based on the discussion above, Applicants respectfully propose that this restriction requirement, which divides single claims into different groups, has been made in error. Accordingly, Groups I and II (Independent claim 1) should be combined into a single group.

In light of the above arguments, Applicants respectfully request reconsideration and withdrawal of the instant Restriction Requirement, which treats dependent claims 2 and 5 as a separate invention from the rest of claims 1-18. In the event that the Restriction Requirement

is maintained, Applicants elect Group II with traverse for the reasons provided above. In either event, Applicants look forward to examination, on their merits in their entireties, of claims 1, 3, 4, and 6-18.

If the Examiner believes a telephone conference would expedite prosecution of this application, he is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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